



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,589	11/08/2001	Bruce A. Bennett	20375-001700	8548

20350 7590 04/21/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT	PAPER NUMBER
----------	--------------

3651

DATE MAILED: 04/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,589

Applicant(s)

BENNETT ET AL.

Examiner

Patrick H. Mackey

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the first paragraph should be properly completed by the applicant.

Appropriate correction is required.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elongate slit nozzle, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 26 and 27 recite the limitation "said sensor". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 28-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Maltman et al. Maltman discloses a mail processing apparatus that includes a track (90), an envelope feeder [®], an inserting mechanism (70), a central nozzle (25b), a side nozzle (25a), an adjust nozzle (50), and a fixture (30).

7. Claims 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by McCain et al. McCain discloses an apparatus that processes mailers (magazines) that includes a track (75), a moving mechanism with a pair of fingers (76-1, 76-2), a grasping mechanism (20-1, 20-2), an elongate slit nozzle (89) coupled to the grasping mechanism (20-1, 20-2), a bin (10), and a vacuum finger (26).

8. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Muller. Muller discloses a method for processing mailers (magazines) that includes passing first and second sheets (P) along a track (14), adding an insert to the first sheet (see col. 4, line 15) by grasping the insert with a grasping mechanism (12a), moving the insert onto the first sheet (see col. 4, line 15), and holding the insert to the first sheet by directing a gas stream onto the insert (see Fig. 3 and col. 5, lines 19-46).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCain et al. in view of Manley. McCain et al. discloses all the limitations of the claims, but it does not disclose a pressure sensor or optical sensor adapted to detect if an insert has been grasped or if more than one insert has been grasped by the grasping mechanism with an indicator and an interrupt circuit. However, Manley discloses an apparatus for handling mailers (newspapers) that includes a pressure sensor (146) or optical sensor (incorporating US 4,753,430 item 80 by reference at col. 13, line 33) adapted to detect if an insert has been grasped or if more than one insert has been grasped (incorporating US 4,527,793 item 5 by reference at col. 13, line 33) by the grasping mechanism with an indicator (see col. 12, line 30, "signal") and an interrupt circuit (see col. 12, line 9) for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence (see col. 2, lines 1-30). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify McCain by utilizing a pressure sensor or optical sensor adapted to detect if an insert has been grasped or if more than one insert has been grasped by the grasping mechanism with an indicator and an interrupt circuit, as disclosed by Manley, for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence.

Art Unit: 3651

11. Claims 1-4, 6, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter et al. Newsome discloses an apparatus for processing mailers (magazines) that includes a paper feeding mechanism (30), a collection bin (33), a retrieval mechanism (38), and a printer (see col. 3, line 23). Newsome discloses all the limitations of the claims, but it does not disclose a deionizer. However, Otter discloses a collection bin that includes a deionizing static bar (172) for the purpose of preventing curl in sheets (see col. 1, lines 10-20). It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Newsome by including a deionizer, as disclosed by Otter, for the purpose of preventing curl in sheets.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter as applied to claim 1 above, and further in view of Tress et al. Newsome and Otter, together, disclose all the limitations of the claims, but neither reference discloses a foot. However, Tress discloses an insert device that includes a foot (42) for the purpose of ensuring only one sheet is separated from the bottom of a stack. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to utilize a foot, as disclosed by Tress, for the purpose of ensuring only one sheet is separated from the bottom of a stack.

13. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newsome in view of Otter as applied to claim 1 above, and further in view of Hill et al. Newsome and Otter, together, disclose all the limitations of the claims, but neither reference discloses a card attachment mechanism and a folder. However, Hill discloses an insert device that includes a card attachment mechanism (26a) and a folder (86) for the purpose of preparing insert packages that include cards. It would have been obvious for a person of ordinary skill in the art, at the

Art Unit: 3651

time of the applicant's invention to utilize a card attachment mechanism and a folder for the purpose of preparing insert packages that include cards.

14. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller in view of Manley. Muller discloses all the limitations of the claims (see above), but it doesn't disclose sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding. However, Manley discloses sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence. It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Muller, by sensing whether the grasping mechanism has grasped only one insert or has grasped more than one insert and ceasing the passing and adding, as disclosed by Manley, for the purpose of preventing improperly formed mailers from being formed while maintaining the mailers in a delivery sequence.

Conclusion

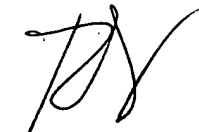
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

Art Unit: 3651

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 746-3750 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to be 'PM' or similar initials, written in a cursive style.

Patrick H. Mackey
Primary Examiner
Art Unit 3651

April 17, 2003